

ROBERT T. TRICK
USSN 08/100,019

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REMARKS

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Applicant respectfully requests reconsideration and allowance of this application in view of the amendments above and the following comments.

Claims 7 and 15 were rejected under 35 USC § 112, first paragraph, as being broader than the enabling disclosure. In response, Applicants ask that the Examiner reconsider and withdraw this rejection. It would readily occur to any person skilled in the art that the claimed films could be made by adding to a Polaroid-type film a top layer of plastic film that has the desired border shape and pattern on it (i.e., the top layer was exposed and developed in the factory) and place this top layer over the regular film. This top layer would be impervious to light and would act as the decorative border. The central portion framed by the top layer would remain unexposed until the consumer used it. The film containing the two layers thus described would be packaged and sold. The consumer would then put the film into the camera, take the picture, and thereby practice the invention of claims 7 and 15.

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Since, as stated by the Court in Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 81, 94 (Fed. Cir. 1986), "a patent need not teach, and preferably omits, what is well known in the art (emphasis added)," even if the specification did not teach this procedure, claims 7 and 15 are enabling since this procedure would have readily occurred to any person having ordinary skill in the photographic art at the time the present invention was made. Therefore, the Examiner would be fully justified to reconsider and withdraw this rejection on this basis alone.

Alternatively, it would have readily occurred to any person having ordinary skill in the art that, for example, a Polaroid-type film having a pre-developed portion could also be prepared by providing the film with two separate chemical development zones overlaying one another which can be exposed and developed independent of each other as illustrated in the attached drawing sheet. The surrounding border can be one separate layer (Fig. 10) which has its own pair of developer pods (Fig. 9). It is chemically separated from the other, central zone, meaning the chemicals in this zone can not reach or seep into the central zone. The central film area is on another separate layer (Fig. 11b) and it too has its own developer pod (Fig. 9) and is chemically isolated from the other zone. In the factory, the border is exposed and only its corresponding pods are broken to release the developer. This develops the border. The film units are then packaged this way. Later, when the consumer uses the film, the central area is exposed and its

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developer pod is broken to release the developer and a central image is thus formed.

In view of the foregoing, Applicants submit that the Examiner should reconsider and withdraw this rejection.

The sole remaining issues for consideration are the final rejections of 1) claims 1-3, 6, 8, 10, 11, 14, 16 and 17 under 35 USC § 102(b) as being anticipated by either Ames or Guez and 2) claims 4, 5, 12 and 13 under 35 USC § 102(b) as being anticipated by either Ames or Guez or, in the alternative, under 35 USC § 103(a) as being obvious over Ames or Guez in view of Jones.

In response to both rejections, Applicant points out that he previously argued that the Examiner had not given proper weight to Applicant's claim limitation that the claimed product is "A sealed package of photographic film." In response, the Examiner makes two points: First, the teachings of Guez at column 10, lines 40-47, read upon Applicant's claim language. Second, this feature is generally considered inherent in the commercial sale of film packages.

Taking these points in order, Applicant cannot find a teaching or suggestion at column 10, lines 40-47, of Guez of a sealed package of film as presently claimed or, for that matter, of any sealed package of film. Applicant points out that the claim

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language "A sealed package of photographic film" means, for example, that photographic film having the elements of claim 1, namely a plurality of exposable photographic frames, each comprising an unexposed portion and an exposed portion, has been placed into a package and sealed. This concept is nowhere taught or suggested by Guez.

Although Guez does teach pre-exposure of a portion of film, and then later exposure of the remaining portion, Guez does not teach or suggest anywhere that between exposures the film is packaged and sealed. Consequently, a limitation of the instant claims, i.e., that the partially exposed film be "a sealed package", is not taught by Guez. Accordingly, Guez cannot possibly anticipate the present claims.

On the issue of inherency, Applicant would call the attention of the Examiner to Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990), which provides in no uncertain terms that:

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. [Italics in original and underlining added.]"

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See, Levy, 17 USPQ2d at 1464.

There are a large number of other decisions to the same effect. See, for example, In re Oelrich et al., 212 USPQ 323, 326 (CCPA 1981) (Rejection reversed because claimed limitation "is not inevitably present" in the prior art device).

In view of the foregoing, Applicant submits that the Examiner's position that "a sealed package" of film is inherent in Guez or in the "commercial sale of film packages" is untenable. While the latter might be true as a general proposition, i.e., that films sold commercially are generally packaged, the Examiner has not shown that the previously commercially available films met the other terms of Applicant's claims, namely that such films "necessarily" or "inevitably" comprise a plurality of already partially exposed frames. Clearly, the Examiner cannot show this otherwise the claims would be rejected over such prior art.

Regarding the former proposition, i.e., Guez, there is nothing therein that would require that the film be packaged and sealed between exposures. Indeed, the film could be rewound and maintained in the camera between exposures as seems to be implied by the Guez disclosure itself. Accordingly, the concept of a sealed package of film comprising a plurality of already partially exposed frames does not "necessarily flow" from the teachings of Guez, nor can such a sealed package of film

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be said to be "inevitably present" in Guez.

Respectfully, Applicant still does not see where in either Ames or Guez, there is any teaching of a sealed package of film having the claimed characteristics. In the absence of such teaching, neither reference can anticipate any of the present claims. And, in the absence of such teaching and a secondary reference that would motivate a person of ordinary skill in the art to package the films of Ames or Guez, neither reference can render obvious any of the present claims.

Applicant would remind the Examiner that an applicant has a statutory right to a patent unless the Examiner that the claimed invention is not novel or unobvious according to well-established principles. Whatever the Examiner's opinion of the merits of the invention, this must give way to the fact that the invention is novel and unobvious from the cited prior art. Under those circumstances, which Applicant submits are present here, the Examiner should simply issue the patent.

Instead, the Examiner maintains these clearly untenable rejections on the grounds that the prior art reveals processes for preparing a composite photograph of two images by exposing one portion of the film to a first image and later exposing the remaining portion of the film to a second image. Even if true, this is not what

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Applicant claims.

Applicant claims a sealed package of film, wherein the film in the package is already exposed on a portion of each of the photographic frames, and therein lies the heart of the invention. The package of film can be sold to the masses, who can use the film in their cameras to photograph on the unexposed portion of the film and, thereby, make a composite photograph. The invention, thus, overcomes the need in the art for specialized devices and expertise in order to achieve this goal. The invention is simple, widely useful, and of practical importance.

Moreover, the invention in Ames actually relates to a complex apparatus, whereby through the successive use of two cameras labeled C' and C, respectively, the background design and the central image are photographed onto the paper in successive steps. Most importantly, the paper proceeds directly from C' to C. Accordingly, there is no teaching of "A sealed package of film," as presently claimed. Moreover, there is no need to package the partially exposed film. Indeed, packaging the partially exposed film only makes sense where, as here, the film is intended to be sold partially exposed, with the composite photograph to be completed by the user.

In short, Applicant sees nothing in Ames that amounts to an anticipation.

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On the issue of obviousness, Ames was combined with Jones. However, the obviousness rejection was dependent upon Ames constituting an anticipation of claim 1, which it does not. Moreover, Jones was cited to show that it was known to use masks to create decorative borders. However, even if the Examiner's assessment of Jones were accurate, the combination of Ames and Jones still would not suggest the present invention. Nothing in Jones overcomes the prejudice established by Ames of preparing the composite photograph in a series of directly linked photograph actions, i.e., without intermediate packaging of partially exposed film. Accordingly, nothing in the combination of Ames and Jones would lead a person of ordinary skill in the art to package a partially exposed photographic film, as presently claimed.

Regarding Guez, as noted above, he also does not describe "A sealed package of film," as presently claimed, i.e., wherein the package that is sealed contains partially exposed photographic film. Accordingly, again, Applicant does not see anything in Guez that amounts to anticipation.

As also noted previously, Guez does teach pre-exposure of a portion of film, and then later exposure of the remaining portion. However, this is effected through a complex scheme, which requires that the film be rewound carefully, and carefully

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repositioned after all of the partial exposures are made. See column 10, line 40 ff. Moreover, there is no teaching or suggestion that prior to such rewinding, the film is packaged and sealed. So, again, Guez does not anticipate the present claims.

On the issue of obviousness, Guez was combined with Jones. However, the obviousness rejection was, again, dependent upon Guez constituting an anticipation of claim 1, which it does not. Moreover, Jones was cited to show that it was known to use masks to create decorative borders. However, even if the Examiner's assessment of Jones were accurate, the combination of Guez and Jones still would not suggest the present invention. As was the case with the combination of Ames and Jones, nothing in Jones overcomes the prejudice established by Guez of preparing the composite photograph without intermediate packaging of partially exposed film. Accordingly, nothing in the combination of Guez and Jones would lead a person of ordinary skill in the art to package a partially exposed photographic film, as presently claimed.

Applicant believes that the foregoing adequately deals with all outstanding objections and rejections.

Applicant further believes that this application is now in condition for immediate allowance. However, should any issues of a minor nature remain, the

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Examiner is respectfully requested to telephone the undersigned at telephone number (914) 332-1700 so that the issues might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

SPRUNG KRAMER SCHAEFER & BRISCOE

By

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment Under 37 CFR 1.116 and the accompanying Petition for Extension of Time and Drawing (Figs. 9, 10, 11a, 11b and 12) (14 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date March 16, 1999

By

Kurt G. Briscoe